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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/785,262	02/24/2004	Yoichi Morimoto	FUJO 20.967	8916

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KATTEN MUCHIN ROSENMAN LLP  
575 MADISON AVENUE  
NEW YORK, NY 10022-2585

EXAMINER
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LEE, JUSTIN YE

ART UNIT	PAPER NUMBER
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2617

MAIL DATE	DELIVERY MODE
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06/27/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/785,262	<b>Applicant(s)</b> MORIMOTO, YOICHI	
	<b>Examiner</b> Justin Y. Lee	<b>Art Unit</b> 2617	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 03 April 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3,5 and 9-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3,5 and 9-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

**DETAILED ACTION**

***Response to Amendment***

1. This Office Action is in response to amendment filed on 4/3/2007.

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 9-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bach et al. (US 6,377,795) in view of Walsh et al. (US 6,748,068 B1) and further in view of McBride et al. (US 2002/01114431 A1).

Consider claims 9 and 11. Bach teaches a portable terminal device (Col 1 Line 63) and a method for preventing one-time only calls to a portable telephone set, comprising:

retrieving data from a telephone directory database if a call arrives at a portable terminal device, and determining whether an originating number is registered in the telephone directory database (Col 2 Lines 26-33); and

Bach et al. do not disclose immediately connecting the call without emitting a dial tone if the originating number is not registered in the telephone directory database, announcing a recorded message.

Walsh et al. further disclose immediately connecting the call without emitting a dial tone if the originating number is not registered in the telephone directory database, announcing a recorded message (col. 2, lines 65- col. 3, lines 9 and col. 3, lines 62- col. 4, lines 7, call is connected to a message recorder that prompts the calling party for identification and record the identification if the caller ID of the calling party is not registered within a caller ID database).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the teachings of Walsh et al. into the teachings of Bach et al. for the purposes of collecting more information about the calling party before making a decision on accepting or rejecting the call (col. 3, lines 1-9).

Bach et al. and Walsh et al. do not disclose announcing a prearranged recorded nonsensical message.

McBride et al. further disclose announcing a prearranged recorded nonsensical message (Fig. 3 steps 115-119 and Fig. 10 steps 215-217 and 246 and paragraph 85 and 92, after a call is received, the caller ID is checked against a approved list. If the caller ID is not found in the approved list, a custom or canned greeting (prearranged recorded nonsensical message) is played to the caller. All these steps are done before the phone rings. The ring does not start until Fig. 10 step 220).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the teachings of McBride et al. into the teachings of Bach et al. and Walsh et al. for the purposes of providing a user to have full control of his/her phone calls to prevent unwanted calls (paragraph 19-22).

Consider claims 10 and 12. Bach et al. and Walsh et al. and McBride et al. further disclose if the originating number is registered in the telephone directory database, the telephone directory database is further retrieved, and if the originating number is for a call set to a zero-calling time, the call is immediately connected without a dial tone and a recorded message is announced to the originator. (Bach et al., col. 2, lines 26-33 and 43-46 and 54-58 and col. 6, lines 11 and Walsh et al., col. 2, lines 65-col. 3, lines 9 and col. 3, lines 62- col. 4, lines 7).

4. Claims 1, 2, and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bach et al. (US 6,377,795) in view of Walsh et al. (US 6,748,068 B1) and further in view of Callele (US 5,206,900) and further in view of McBride et al. (US 2002/01114431 A1).

With respect to claim 1, Bach et al. teaches a portable terminal device (Col 1 Line 63) and a method for preventing one-time only calls to a portable telephone set, comprising:

a determination unit retrieving data from a telephone directory database if a call arrives at a portable terminal device, and determining whether an originating number is registered in a telephone directory database (Col 2 Lines 26-33);

a transmitting unit immediately connecting the call (Col 2 Lines 43-46).

Bach et al. do not disclose immediately connecting the call without emitting a dial tone if the originating number is not registered in the telephone directory database, and announcing a recorded message.

Walsh et al. further disclose immediately connecting the call without emitting a dial tone if the originating number is not registered in the telephone directory database, and announcing a recorded message (col. 2, lines 65- col. 3, lines 9 and col. 3, lines 62- col. 4, lines 7, call is connected to a message recorder that prompts the calling party for identification and record the identification if the caller ID of the calling party is not registered within a caller ID database).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the teachings of Walsh et al. into the teachings of Bach et al. for the purposes of collecting more information about the calling party before making a decision on accepting or rejecting the call (col. 3, lines 1-9).

Bach et al. and Walsh et al. do not disclose a charge is imposed on an originator side when the call is connected.

Callele further discloses a charge is imposed on an originator side when the call is connected (col. 1, lines 13-15, the calling party is being charged when the called party directs the call to a recorded message).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the teachings of Callele into the teachings of Bach et al. and Walsh et al. for the purposes of annoying the calling party (col. 1, lines 6-15).

Bach et al. and Walsh et al. do not disclose announcing a prearranged recorded nonsensical message.

McBride et al. further disclose announcing a prearranged recorded nonsensical message (Fig. 3 steps 115-119 and Fig. 10 steps 215-217 and 246 and paragraph 85 and 92, after a call is received, the caller ID is checked against a approved list. If the caller ID is not found in the approved list, a custom or canned greeting (prearranged recorded nonsensical message) is played to the caller. All these steps are done before the phone rings. The ring does not start until Fig. 10 step 220).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the teachings of McBride et al. into the teachings of Bach et al. and Walsh et al. and Callele for the purposes of providing a user to have full control of his/her phone calls to prevent unwanted calls (paragraph 19-22).

Consider claim 2. Bach et al. and Walsh et al. and Callele and McBride et al. together further disclose wherein if the originating number is registered in the telephone directory database, the telephone directory database is further retrieved, and if the originating number is for a call set to a zero-calling time, the call is immediately connected without a dial tone so that a charge is imposed on an originator side and a

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recorded message is announced to the originator (Bach et al., col. 1, lines 63, col. 2, lines 26-33, Col 2 Lines 43-46, Col 6 Line 11, Col 2 Lines 54-58 and Walsh et al., col. 2, lines 65- col. 3, lines 9 and col. 3, lines 62- col. 4, lines 7 and Callele, col. 1, lines 13-15).

With respect to claim 5, Bach et al. and Walsh et al. and Callele and McBride et al. together further disclose the portable terminal device according to claims 1 &2, wherein after the recorded message is announced to the originator, a message from the originator is recorded (Bach et al., Col 2 Line 65-Col 3 Line 11).

5. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bach et al. (US 6,377,795) in view of Walsh et al. (US 6,748,068 B1) and Callele (US 5,206,900) and McBride et al. (US 2002/01114431 A1) as applied to claim 1 and further in view of Cannon et al. (U.S. 6,026,152).

Bach et al. and Walsh et al. and Callele and McBride et al. together disclose the portable terminal device according to claim 1. Bach et al. and Walsh et al. and Callele fails to expressly disclose the zero-calling time setting is made in a recorded message response time area of the telephone directory database.

In the same field of endeavor, Cannon teaches a similar device wherein the zero-calling time setting is made in a recorded message response time area of the telephone directory database (Col 2 Lines 35-41; Col 3 Lines 49-50).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to make the zero-calling time setting in a recorded message



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response time area of the telephone directory database, so the setting can be directly associated with the different numbers in the database.

### ***Conclusion***

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.


7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Justin Y. Lee whose telephone number is (571) 272-5258. The examiner can normally be reached on M - F 8:30 to 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Duc Nguyen can be reached on 571-272-7503. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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